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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/824,889 | |
| | Filing Date | 04/14/2004 | |
| | First Named Inventor | Toby Wexler | |
| | Art Unit | 1644 | |
| | Examiner Name | Kimberly Smith | |
| Total Number of Pages in This Submission | 20 | Attorney Docket Number | |

| ENCLOSURES (Check all that apply) | | |
|--|--|---|
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| Printed name | Robert N. Montgomery | | |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE,

**DATE: 29 June 2007
SERIAL NO. 10/824,889
FILED: 04/14/2004**

**APPLICANT: Toby Wexler
GROUP ART UNIT: 3644
EXAMINER: Kimberly Smith**

FOR: An animal toe nail covering and method of manufacture

**Commissioner of Patents
P.O. Box 1450 Alexandria VA 22313-1450**

REPLY BRIEF of APPELLANT

**This is a REPLY BRIEF in response to EXAMINER'S ANSWER dated May 25, 2007
made in response to applicant's brief filed May 23, 2006**

REAL PARTY OF INTEREST- Toby Wexler

(Appellant represented by Robert N. Montgomery Registered Patent Agent 35,291.)

REPLY TO EXAMINER'S RESPONSE TO APPLICANT'S ARGUMENTS

- (1) At issue is the very basic question regarding the applicability of the "*Field* U.S. Patent 4,908,881" as a valid reference under 35 USC 102 and 103. Under 35 USC 102 a cited reference must teach each and every element of the claim including all limitations of the claim when taken as a whole.

The *Field* reference teaches a covering for the first joint of a human finger or toe to which a decorative plastic appliqué in the form of an artificial fingernail may be attached for esthetic purposes. The covering, according to *Field*, has a "closed pouch-like distal tip generally shaped to snugly receive and correspond to the anatomical shape of a human finger". The covering may also be made of cloth. The intended purpose of the fingernail covering is to protect the human fingertip from injury.

Applicant claims "An animal toe nail covering having a opening at one end and a internal and external shape defining a pliable sheath generally consistent with that of an animal's toenail, said polymeric sheath comprises an external coating of polymer encompassing at least a portion of said polymeric sheath."

The intended purpose as disclosed in the specification is to encapsulate an animal's toe nail and thus protect humans and their habitant from the ravages often wrought by an animal's nails. The covering or sheath is applied only to the animal's nail and not the animal's toe. The specification makes no mention of protecting the toe nail from harm.

The applicant's invention is applied only to the animals toenail and not to the animal's toe. Of important distinction is that the animal's toenail is in fact a "claw" and not a finger or a toe. The claw is part of the skeletal system, arising from bony germinal tissue in the end of phalanx. The claw extends out past the end of the toe, is a conified structure, more similar to a cow horn than a human finger. In absolute contrast, the human finger has attached on its dorsal aspect a thin nail, which is only attached to subcutaneous structures such as fat and muscle. The human fingernail is not attached to the skeletal structures of the finger and makes every little anatomic difference to the finger's shape whether attached or unattached. It is impossible to cover a human finger with the Field Finger Guard without also covering the nail. It is likewise impossible to cover an animal's toe with the Field Finger Guard. Applicant's invention speaks only of covering the nail portion or claw of an animal without encompassing the toe, demonstrating the basic anatomic and operational differences between the two.

Functionally these two inventions are incomparable. A human finger missing The nail can still wear the Field Digit Guard whereas; a de-clawed cat or dog cannot wear applicant's current invention. Such is the radical difference between something, which fits onto a finger and something which fits onto an animal claw.

Further, the animal claw telescopes to a needle sharp tip. The current invention likewise telescopes to a point whereas; a human finger keeps its width and thickness throughout its length. The Field invention will fit over any section, or as many sections of the human finger as needed. The applicant's current invention can fit over only one specific aspect of the animal's anatomy, the sharp claw. It cannot extend beyond the claw, is limited to the claw, and is absolutely dependant on the existence of a claw. Furthermore, it is impossible to use the Field finger covering to cover only the human fingernail exclusive of the finger. Whereas applicant's invention with respect to the animal's anatomy, covers the animal's claw exclusive of the toe itself.

Further, the inventor as the sole producer of such covering in the United States under 3 USA patents 4,962,731, 7,069,879 and Des 3,299,928 recognized the need to improve the longevity of the covering by applying a second layer or coating of polymer. This innovation is a significant aspect of the invention and has been completely overlooked by examiner. The longevity of the finger covering disclosed by the *Field* reference is not increased at all by adding the artificial fingernail.

Obviously the *Field* covering is made differently and used for an entirely different purpose. In fact adding the artificial decorative nail to the exterior of a finger covering defeats the purpose of applicant's sheath by adding an external nail.

Examiner has failed repeatedly to distinctly point out where the *Field* patent teaches or suggest the use of the *Field* covering for animals or the use of the *Field* finger covering as being applicable to encompassing only the nail alone. *Field* makes no mention of a nail even being on a finger or toe thus the nail being covered by it is only assumed by examiner. Therefore, there is nothing to indicate the finger or toe mention by Field even has a nail, the nail could have been removed as a result of amputation. In any case the covering is designed to cover the entire fingertip and not simply the nail portion.

Applicant therefore contends that the instant invention distinguishes over the cited reference of *Field* in that the reference does not teach or otherwise suggest each and every limitation of applicant's independent claims 1, 27 and 32 under 35 USC 102 and that applicant's claimed toenail sheath is in fact made in an entirely different manner for an entirely different purpose. The likelihood of the covering, cited in the reference of *Field*, performing the intended purpose (including increasing the longevity of the article) as prescribed by applicant is impossible.

Under 35 USC 103 as relating to dependent claim claims 3, 6, 7, 14-17, 29, 36, 38 and 39, whereby analogous art is required, examiner has gone beyond the scope of the established classification search parameters established by the PTO in class 119/861. The PTO search division and examiners in three other issued patents also

did not feel the need to search the classification 2/21. Those skilled in the art are not required to search very possible classification, only the most relevant art. This in and of itself does not eliminate the reference of *Field* with regard to obviousness. However, it does make it suspect. Using the same reference for both 35 USC 102 and 103 rejections is also highly unusual.

With regard to obviousness under 35 USC 103, the cited reference of *Field* must clearly suggest the combinations as claimed by applicant as a whole and further be aligned with the applicant's principles of operation. Under 35 USC 102 and 103 all limitations must be considered. Even the preamble in applicant's claim clearly limits the claims to "animal toe *nail* coverings" and not human fingers or toes.

Therefore, regarding Claims 3, 29 and 36 the reference clearly does not suggest the combination of an "animal toe *nail* sheath having an "external coating" of polymer having a different color than the "polymeric sheath". Substituting a detachable decorative plastic member of a different color for an external coating is clearly an improper equivalent.

Regarding claim 6, the *Field* reference never mentions an adhesive. Therefore, there is no such combination of an "animal toe nail sheath" having a "polymeric sheath" and an "adhesive element". Examiner's argument that an adhesive must have been used is a clear expression of hindsight and not a direct reading of the reference.

Regarding claims 7, 14-17, since the *Field* reference fails to mention an adhesive, it can't possibly anticipate, teach or otherwise suggest a type of adhesive, where, or how such an adhesive is or could be used in combination with the sheath.

In addition, claim 1 of *Field* teaches a generally tubular section of material and the FUSING of the opposing edges of one diagonally cut end of each individual segment. The act of sewing or fusing the opening of a generally tubular piece of material will create a seam. This also seems to refute examiner's claim of an adhesive being used in some manner to make the sheath. To fuse is simply to close, making no reference to an adhesive, a tube creating a straight line. Whereas, applicant's invention is a dipped vinyl part, having a smooth continuous end devoid of any seam, or fusion at the tip, or end. The presence of a seam or fusion is the result of the closure of a tubular structure. One could not place a seam or fusion in the end of a structure, which is shaped, consistent with that of an animal toe nail or claw. The animal toe nail or claw is pointed and is already a termination devoid of any sort of tube. One likewise cannot cut a series of claw shaped objects from a continuous generally tubular source of material. A generally tubular source would keep its opening through out, or it would not be a tube of any kind. The tip of the claw however is a point, and is not tubular. A tube is open in its center; a sharp point is a termination and is closed. One cannot have a generally tubular source of material with an opening throughout its tube and still make claw shaped cuts,

which require a seam. The shapes are mutually exclusive. Field gets even more specific in (c) fusing the opposing edges of one diagonally cut end. Clearly Field is not creating a point or there would be no opposing edges to connect. It would not be reasonable to anyone familiar in the art of veterinary science to expect a device made in such a way to be claw shaped. Furthermore, it would not be reasonable to anyone familiar in the art to want a seam or fusion at the end of the cover, as this is also where the sharp point of the claw resides. Regardless, The Field method precludes one from making claw shaped devices following his methods.

Further, in claim 6 applicant claims a polymeric sheath comprising an adhesive element. Since the Field Reference makes not mention of an adhesive element at all examiner has no foundation for where the hypothetical adhesive she insist must be present is located. If present at all one would think that Field would have claimed or at least mentioned an adhesive element as an essential combination to the sheath. The purpose of the adhesive as disclosed by applicant (and which should have been taken into consideration) is to attach the sheath to the animal's nail and not to attach decorations to a finger guard in some detachable manner. There is no indication by Field that the decorations are attached by an adhesive, if they were so attached they would not be detachable.

Regarding claim 38, the reference of *Field* clearly does not teach or suggest the combination or supply a motivation for using a human finger sheath as an Animal toenail (toe *nail*) cover. *Field* certainly does not teach the combination of an Animal Toenail sheath having a "rectangular opening" as shown by applicant in Fig. 7, nor is the sheath consistent with the shape of an animal toenail. The *Field* finger covering does not teach or suggest a telescopic relationship over and animal toenail nor does it encase and provide protection from the animal's toenail. The *Field* artificial detachable finger nail simply does not rise to the equivalency of a polymeric overlay coating conforming to the general shape of the external surface of an animal toe nail sheath as disclosed by applicant.

(2) EXAMINER'S ARGUMENTS

Regarding Claim 1 rejected under 35 USC 102, examiner recites MPEP 2131.05 as her authority to cite any prior art that she deems relevant. However, rule 2131.05 is not without limitations. The rules also specifies that to anticipate a claimed invention under 35 USC 102 the prior art reference must disclose all of the elements of the claimed invention or their equivalences, functioning in substantially the same way to produce substantially the same result. In this case the cited reference of *Field* does not disclose all of the claimed elements i.e. an "animal toe nail sheath". The *Field* covering has nothing to do with an animal or its skeletal toe nail. The reference teaches a finger

covering that may or may not have a nail thereon. The reference does not suggest in any way that the *Field* covering has a shape that is consistent (which by definition is being consistent with the known facts) with in this case an animal toe nail. Consistent does not mean something that is inconsistent with an animal toe nail or something that is all encompassing or mean whatever examiner wishes. Further, the cited reference does not teach or suggest that the covering has an external polymer coating nor does the attachable decoration “encompass” any portion of the covering. Ignoring the claim’s limitations is not permissible and thus does not comply with the rule.

Simply adding a decorative piece of plastic to the finger covering described by *Field* does not suggest in any way that the finger covering could be placed on an animal nail with any reasonable expectation of success and thus be used to protect people or property from the animal’s nails or that such a covering would improve the wear characteristics of the sheath. Therefore, applicant contends that the cited reference of *Field* is non-analogous.

Examiner’s remark that the claim *merely* requires the sheath to have “a shape generally consistent with that of an animal’s toenail” is an indication of examiner disregard for the rules under 35 USC 102. The cited reference must contain each and every limitation of the claim. A shape generally consistent with that of an animal’s toenail embodied by applicant’s claims is not a suggestion but is a clear limitation. To be consistent by definition the reference must not be *inconsistent* with the known facts relating to an animal’s nail as defined in detail by applicant’s specification. Even a cursory inspection of an animal’s foot, as shown and described by applicant in his previous patent and incorporated in the instant application by reference, indicates that the toe nail is part of the animal’s skeleton and not the flesh portion of the toe.

According to MPEP 2111.02 the preamble of applicant’s claim 1 when read in the context of the entire claim clearly recites the structural limitations of an “animal toe nail covering defining a sheath having an internal and external shape that is consistent with an animal’s toe nail”. Such a limitation is further necessary to give life meaning and vitality to the claim. Only by the phrase “animal toe nail covering” and its limitations would one be able to discern the subject matter

Examiner chooses to argue with applicant’s explanations rather than supporting her reasoning in support of the inconsistencies in the *Field* reference relative to the shape of an animal nail.

Examiner’s statement that the *Field* reference discloses a covering having a shape that is generally consistent with that of an animal nail and that the reference is inclusive but not limited to animals such as grizzly bears that have claws generally consistent with the shape of a human finger is absolute false. This statement is at the root of examiner’s

misunderstanding of the rules and her failure to grasp even a basic understanding of human or animal anatomy as fully described by applicant's specification.

An animal nail or claw in most cases is an extension of the skeletal structure of the animal foot or toe bones as shown and describe in patent No. 4,962,731 by Wexler and incorporated by reference into the present application. The nail or claw does not include the flesh portion of the toe. Whereas, humans do not have claws and the nail is not attached in any way to the skeletal structure of the foot or hand. Bears or grizzly bear nails or claws in particular are no different from other animals. It is incomprehensible as to how or why anyone would be motivated to cover a bear's nails or claws with the *Field* covering having a decorative artificial fingernail. Especially when prior art already exist (see Patent 4,962,731) that is specifically intended to cover such animal nails or claws.

At central to this debate is the use of the term DIGIT GUARD in the Field patent.

Claim one: A method of manufacturing a DIGIT GUARD

Claim Two: Attaching selective decorative accoutrements to said hollow pouch so as to form a DIGIT GUARD...

Both claims clearly specify DIGIT GUARD. The claims do not say consistent with the shape of a digit, but does limit the scope to a DIGIT GUARD.

Webster defines "digit" clearly and precisely: Digit; from Latin Digitus, a finger or toe.

Field interchanges his description for his DIGIT GUARD and FINGER GUARD no less that 15 times. He also wishes to encompass any anatomical "DIGIT" meaning fingers and toes. If any other digits do exist Webster's dictionary is not familiar with them, nor is modern medicine. The words FINGER, DIGIT AND TOES can and are commonly used synonymously. However the finger is an appendage found on primates and is of a hand. It is doubtful that Field ever envisioned the possibility of protecting the false finger nails or fingers on any non-human primates.

Whereas, the current invention however is not concerned with digits, fingers OR toes, only animal TOE NAILS. Again Webster defines CLAW as: A sharp, slender, curved NAIL ON THE TOE OF AN ANIMAL.

The word CLAW is by definition an ANIMAL TOE NAIL. A shape consistent with an animal toe nail is that of a slender, curved, sharp, nail. Applicant has stated that the sheath's shape is consistent with that of an animal toe nail and this has caused the examiner great consternation. However, a reasonable person would agree that because of the range of shapes between cats dogs and bears, using the geometric description "as

consistent with an animal toe nail" merely serves to limit the scope of the current invention to a SHARP and SLENDER and CURVED, NAIL OF an Animal. All claws share these same limitations. The human finger or digit is not a claw; the human finger is not sharp but blunt, not slender but oval, not curved but rather jointed and flexible, "and certainly does not arise from the TOE OF AN ANIMAL." Thus it is not reasonable to call a digit a claw, and it is not reasonable to infer the Field DIGIT GUARD would fit a claw or a tooth or a horn. To be reasonable one would not expect to apply it to anything other than a finger or toe. FURTHERMORE, since a digit does not arise from the toe of an animal, as does the claw, no reasonable person would infer that a digit guard is a claw cover.

For the purposes of anatomy, the term Animal toe nail is synonymous with the term Claw. They are one in the same. They only describe a SHARP AND SLENDER AND CURVED NAIL. Furthermore, the claw is detachable from the toe and can break off and re-grow. A digit cannot break off and re-grow. A human nail by contrast is not a CLAW. It is not curved but flat, not slender but still thin and flat and does not arise from the toe of an animal, but a human or primate. Still further, to be slender and sharp denotes a point, of which any reasonable person would agree is one of the most fundamental difference between a claw and a human nail, which is the dramatic ripping point of the predatory claw unlike the rather blunt straight end of the human finger.

However as defined earlier, a digit is only a finger or toe. Therefore the terms Claw and Digit are NOT synonymous. They are exclusive of each other. The claw comes from the toe, and the toe is a digit. Furthermore, in the scope and specification of the Field patent Field interchanges the terms Finger guard and Digit guard so often as to make clear his use of the word Digit as a Finger. But regardless, a reasonable person would agree that in Claim 1 of the Field patent his use of the word Digit GUARD, along with the acceptable Webster's definition of DIGIT precludes one from any other conclusion than a DIGIT GUARD that fits a Digit of any kind simply cannot also be a CLAW Cover. Such is the radical difference in both their shape and their definition.

Field repeats often his intention of the DIGIT GUARD TO QUOTE " CONFORM TO THE ANATOMIC CONTOURS OF THE HUMAN FINGER". ... Again under (C) Shaped to snugly receive and correspond to the anatomical shape of the human finger.

While the broadest interpretation of DIGIT GUARD IS FINGER GUARD OR TOE GUARD, a finger or toe is not a sharp, slender, curved, nail arising from the toe of an animal. Beyond any reasonable line of thought, the Field apparatus cannot be both a claw cover and conform to the definition of the current invention as only covering the animal claw or nail, and also maintain the claimed method of being a Digit guard which is a finger or a toe guard. Furthermore Field cannot conform to the anatomical shape of the human finger, and be still slender, and sharp and curved and arise from the toe of an animal. Especially since the two structures are of two totally different shapes. Furthermore

they exist on two totally different species. The animal does not have fingers; the human or primate does not have claws. The applicant's invention cannot cover them both at the same time. Furthermore, a DIGIT GUARD as has been pointed out is only designed to cover both the human nail and digit at the same time, while applicant's invention does not cover the digit at all, but only the claw, therefore precluding it from being a Digit guard, Finger guard or Toe guard.

It should also be further clarified that a claw is not a digit, as demonstrated unfortunately in the surgical de-clawing of cats. The operation is not called de- toeing or de-digiting, but scientifically called de-clawing. Applicant points this out to further underscore that the animal's claw or nail is not the toe. But rather the claw arises from the bony structures of the toe. Furthermore, the term toe as it pertains to animals is not to be confused with the term "toe" of a human foot. Dogs and cats including "bears" as well as numerous other animals with claws have paws. You will not find a human medical text, which refers to the human foot as a paw. There are enough differences between the paw and foot and hand as would fill a podiatry text book and are beyond the scope of this brief, but let it be said that there are many, many diseases specific to the paw and claws which are not common to the foot and hand. In fact these are areas of specialty with which medical professionals focus their careers on.

A person not trained in the veterinary arts might well be lead to think that things mentioned in the Field patent are obvious because of loose understandings of terms such as toe and nail and digit. However to those trained in the veterinary arts, references such as the Field's Digit Guards seem nonsensical and meaningless as they pertain to animals. As just a simple example, a dog and a cat paw is webbed between the foot pads of the paw, not to mention that immediately beneath each toe is a large bulbous weight bearing foot pad of which there is no counterpart on the human hand and so the mere suggestion that a digit guard could be placed over each individual toe is ridiculous. First, it could not be made to fit and stay in any possible conformation and even if it could the animal simply could not walk with such a contraption. To a person not trained in the Veterinary Arts the sort of arguments presented by the examiner may seem to be the fodder of a good debate, but in the actual real life practice of Veterinary Medicine there is nothing obvious about Field with respect to animals at all. While terms such as Toe and Digit and Nail may have similar English language use with regards to loose discussions of animals feet and human fingers, the actual anatomy and physiology differences make references such as Field TOTALLY UNOBVIOUS to the trained professional.

Therefore, the Filed reference does not teach, suggest or describe in any way a covering for an animal's nails or the possibility of using the *Field* covering for a human's nail only. As previous argued, the *Field* apparatus covers the human finger and not the nail portion only as claimed by applicant. Examiner has provided no evidence that the *Field* nail covering is capable of being used to cover an animal nail or that such a covering would be effective in reducing wear commonly found in prior art nail sheaths

(shown as prior art) resulting in contact with a rough surface as described on page 11 of applicant's specification.

Examiner's argument regarding the absence of a second layer of polymer in the *Field* reference is irrelevant in view of the fact that the claim was amended using the term "coating" in place of the term "layer". The *Field* reference does not show, suggest or otherwise disclose a coating of anything much less a polymeric coating.

Examiner's argument that applicant's claim or claims do not contain a limitation alluding to the fact that the sheath is only one piece is a blatant misunderstanding of the rules. By claiming a sheath with *no attachable element*, the claim by its very nature distinguishes over a finger sheath with an attachable decorative accessory that serves no useful purpose. The elimination of an element is in it self an innovation. The decorative accessory is not a coating, layer or laminate it is simply a decoration and nothing more, present for esthetic purposes only. Applicant makes this very clear in the brief. Common sense dictates that candles, paste flowers etc. on a cake are not cake layers or laminations.

Examiner's dismissal of applicant's argument that the *Field* reference also suggest that the covering may be made of cloth rather than a polymeric as claimed by applicant's is unfounded. The question becomes would a covering made of "rigid or pliable, plastic or cloth material" all be elements equivalent to those claimed by applicant? Therefore, if the *Field* covering were made using a rigid or cloth material would the *Field* covering still anticipate applicant's sheath. Applicant's sheath is limited to a pliable sheath having a harder more dense outer coating.

Examiner comments that the *Field* decorative artificial plastic fingernail is an external *coating made* of rigid plastic and the sheath is made of a semi-pliable material (except when it is rigid or made of cloth). How can this be, when coatings are not rigid and the term semi-pliable is indefinite? Examiner defines rigid plastic as a plastic that does not yield. Even steel has a yield point and is semi- pliable and malleable under certain conditions.

Examiner rejected applicant's claims relating to the different hardness's of the sheath material and the coating material by arguing that the *Field* reference disclosed that the decorative artificial plastic fingernail by being a rigid plastic must be harder than the semi-pliable plastic sheath, but obviously not if it were made of cloth. This argument is maintained, in spite of the fact that *Field* makes no such disclosure regarding hardness. Examiner, has failed to support such a conclusion, even when applicant argued that the thickness of the material is all that determines the rigidity of a material and not necessarily the density and or hardness of the material.

Examiner's remarks relating to claim 3 would have us believe that the *Field* reference discloses a sheath having an outer coating with a color different than that of the base sheath. When in fact, *Field* only discloses the possibility that the artificial plastic fingernail 48 may be made in different colors. *Field* makes no reference to the color of the sheath or that it is or should be a different color than that of the artificial plastic fingernail. Contrasting colors is a significant limitation. The color of the artificial plastic fingernail is further described as being colored to enhance the esthetics of the sheath. Where as, applicant uses the color to distinguish a coated sheath from an uncoated one. Applicant maintains that no obvious variant is present when only one element is disclosed as being colored and that element (detachable plastic fingernail) is not even present in applicant's application. There is nothing in the *Field* reference that would lead one skilled in the art to use contrasting colors.

Examiner misinterprets the term "cleats" as used by applicant in claim 4 and by using hindsight attempts to broaden the scope of the term to include the term "ribs" as used by the Johns '981 patent. There is no definition for the term "cleat" that includes the term "ribs". The *Johns* reference is a thin rubber finger sheath having a plurality of internal and external ribs extending circumferentially around the wall of the stall. Applicant contends that the ribs disclosed by *Johns* encircling the finger stall do not in any way teach a plurality of internal anticline cleats.

Examiner is not only using hindsight but is taking the claims out of context. Applicant's claim 11 is a dependent upon claim 1. Therefore the claim when taken as a whole reads as follows;

"An animal toenail covering having an opening at one end and an internal and external shape defining a pliable sheath generally consistent with that of an animal's toenail, said polymeric sheath comprising an external coating of polymer encompassing at least a portion of said polymeric sheath and a textured inner wall."

Therefore, when dissection of the claim and the use of hindsight failed to produce the combination or provide motivation to make such a combination failed, examiner makes the unsupported statement that any wall surface other than a specifically claimed smooth wall surface is inclusive of a textured surface. Now the ribs identified in *Johns* suddenly, according to examiner, previously cited as a cleat now becomes all inclusive for textured wall surfaces. The cited reference of *Johns* makes no disclosure of a wall surface that is smooth or textured. There is no known definition for a surface having ribs as being a textured surface. A texture is defined as being grainy or rough derived from the Latin word for weave. The term textured is a limitation by applicant that distinguishes a rough wall from a smooth one. Further, under 35 USC 103 the burden is placed on the examiner to show how one of ordinary skill would have been motivated to combine the teachings of *Johns* with *Field*. The mere fact that the *Johns* reference teaches a sheath (stall) that has internal ribs does not in any logical sense lead anyone of ordinary skill to

assume that the walls of *Field* are, could or should be textured or could or should have ribs or cleats.

It should be noted that any and all terms could be debated indefinitely, if one wishes, even the term "is". However, one would think that common usage of basic none technical terms would be sufficient for PTO examination.

In response to Examiner's comments regarding claim 5. Examiner's first rejection claimed that the *Field* reference has layers by referring to the artificial finger nail as a layer when in fact it is simply a decorative removable attachment. When applicant reluctantly amended the claims by changing the term "layer" to a "coating". Examiner then began referring to the artificial finger nail as a coating. In Claim 5 applicant claims a partial delamination between the sheath and the external coating. Examiner claims that the artificial finger nail is also a lamination, thus removal of the artificial finger nail is a delamination. No explanation was given as to how a partial delamination could be achieved when removing the artificial finger nail.

Applicant contends that the claimed polymeric sheath contains layers or it has an external coating or it is laminated. These are common terms each having specific meanings and are not interchangeable. As a result of such covering or coating means, the life of a basic prior art animal toe nail sheath is extended. Applicant further contends that the cited reference of *Field* makes no suggestion or teaching of a layer, coating or lamination, therefore, the *Field* finger covering does not teach a delamination. Simply removing one object from another does not qualify as a delamination any more so than placing several objects one upon the other thereby forming a stack and not a lamination. It is the adherence of the objects one to the other that forms a lamination. Something must first be laminated before it can be delaminated. A detachable covering is simply not a lamination by any definition and therefore does not anticipate applicant's claimed sheath.

Regarding claim 6, examiner argues that an adhesive is obvious even though the cited reference fails to even mention an adhesive. Applicant contends that the presence of an artificial nail or the lack thereof with or without an adhesive is not essential to the intended use of the *Field* sheath. Applicant teaches the use of an adhesive placed within the sheath in some manner for securing the sheath to the animal's nail. Therefore, the adhesive and its placement within the delaminated portion of the coating is essential for attachment to the animal's nail when punctured during application of the sheath. Applicant also teaches that adhesives also have chemical elements that may be separated so that one element may be applied to the sheath and activated by another element during application. Examiner has failed to grasp this concept by simply reading the claims.

Only when the *Field* sheath has the nail attached does it become a reference and according to examiner they must be attached to form the combination even though it is removable. The question then becomes, "When is it a reference?" This combination also defeats the purpose of applicants wear resistant animal toe nail sheath.

Regarding claim 7, Examiner uses terms like layers, coating and laminations interchangeably although each has very definite meanings. Therefore, the phantom or non disclosed adhesive in the *Field* reference now takes on a definite description according to examiner as being obviously a liquid adhesive or any known adhesive applied between the polymeric sheath and the exterior coating for attaching the coating to the sheath. By reading applicant's specification one would learn that the adhesive referred to in the claims is used to attach the sheath to the animal toe nail and that the liquid adhesive in the form of a liquid is injected between the sheath and the coating within the delamination portion. The mere presence of a liquid adhesive between the coating and sheath is a definite limitation. It is not obvious to any one to do this nor is it obvious by reading the cited reference as to why anyone would need to use a liquid adhesive to adhere a coating to a substrate such as the polymeric sheath. A coating is not necessarily a removable covering. In this case the adhesive liquid is specified as remaining in a liquid state until the inner sheath portion adjacent the delamination is ruptured by the insertion of the animal toe nail. Although the process for placement and activation of the adhesive is not specifically claimed, examiner is not exempted from reading the specification in order to fully understand the its purposes.

Regarding claims 14-17, according to examiners remarks it's doubtful that she has even read applicant's specification. Applicant teaches the use of various types of adhesive and methods of applying such adhesives to the sheath cavity and or the animal toe nail for securing the sheath to the animal's nail. This is accomplished by adding the adhesive to the structure of the sheath in various manners to facilitate the application of applying the sheath to the animal's nails without the extra step of inserting the adhesive within the sheath just prior to insertion of the nail in a telescopic manner within the sheath. Therefore, examiner continues to mistakenly confuse the structure having an adhesive attached thereto for activation in the future with an adhesive used to attach the exterior layer, lamination or coating or an artificial finger nail to the sheath. Therefore, the mere presence of an adhesive as a structural element in the claim does not in itself necessitate its location or use. Examiner in this case refuses to look to the specification for clarification and makes assumptions not in evidence in the cited references and interpreting them broadly as a whole while narrowly defining applicant's claims.

Products by process claims are acceptable under MPEP 2113 provided the product claimed meets the requirements under 35 USC 102 and/or 103. Therefore, regarding claims 16 and 17 applicant contends that the product in the cited reference as argued above does not anticipate nor is the claimed animal toe nail sheath obvious in view of the cited reference. Therefore, if found to be true, the process by which an adhesive is

applied is also allowable. Further, since examiner did not make an argument regarding the placement of the adhesive on the tooling when forming the sheath it would seem that she was aware that a powder adhesive was or could be applied to the sheath forming tool during the manufacturing process. Obviously it never occurred to her that by applying an adhesive powder to the sheath forming tool it would by necessity be within the cavity and not between the formed sheath and a coating. In spite of this examiner keeps insisting that the adhesive must be applied between the sheath and the coating to satisfy her obviousness rejection based on *Field*.

Regarding claims 27, 28, 30, 32-35 examiner states that applicant argues that these claims rejected under 35 USC 102 requires a motivating suggestion. Examiner is taking this out of context. APPLICANT made no such argument regarding ANY specific claims in the appeal brief, applicant was only pointing out that examiner had not responded to the rules cited by applicant in previous amendment remarks that pertain to 35 U.S.C.103.

Examiner's argument, regarding claims 27, 28, 30, 32-35, that applicant has only argued the intended use of the apparatus and has not clearly pointed out or distinctly argued any claim limitation which would preclude the apparatus from being used for human fingers, is absurd and is not factual. The claims all limit the apparatus to an animal toe nail covering having an internal cavity and an external shape defining a pliable sheath generally consistent with that of an animal toe nail. This is clearly a limitation and not a suggested use, such as would be the case had applicant claimed a sheath for covering a toe that may or may not contain a nail the covering perhaps having a decorative artificial nail attachment.

Examiner continues to maintain, although applicant has supplied contrary supporting evidence, the argument that a plastic and a polymeric are equivalents. Those skilled in the art are certainly aware of the differences between the two. Simply because examiner is unaware of such differences does not make the claim limitation obvious.

Examiner's comment that since the claimed limitation of the sheath material being a polyvinyl that is a thermoplastic and that this somehow means that a polymer is in fact a plastic is ludicrous. Even someone with a basic understanding of the sciences understands or should understand that a polyvinyl is a compound with repeating small molecules: a natural or synthetic compound that consists of large molecules made of many chemically bonded smaller identical molecules, e.g. starch and nylon. Whereas "plastic" simply means a material that is formable. The term plastic does not describe a particular material whereas the term "polymeric" does define a type of material. Many polymers are not thermoplastic and thus may not be reconstituted by heat.

Regarding examiner's argument that the *Field* referenced artificial nail somehow encompasses the sheath is totally unsupported by the *Field* reference. In fact the *Field*

reference clearly dictates that “a false fingernail may be detachably mounted within a recess notch 50 formed on the upper surface of the sheath. There is nothing in the *Field* reference that even suggests that the false finger nail encompasses anything. For that matter there is nothing in the *Field* reference to support examiner’s conclusion that the false finger nail is a coating as claimed by applicant.

Regarding claims 28 and 34 examiner continues to argue that a detachable false finger nail is a coating and that a rigid plastic is harder than a semi-pliable material regardless of what material is used. Any technical person knows that different materials cannot be compared in this manner. A semi-pliable material could be any number of materials such as leather or cloth, as suggest by the reference, for example; whereas the term plastic simply means that the decorative material (false finger nail, sequins or beads) is formable. Such arguments with this examiner have resulted in total denial of the technological facts.

Examiner’s answer to the applicant’s brief now makes arguments regarding claims 32 and 33 that were not made in the final rejection. The argument now addresses the claim limitation of the sheath having a non-uniform wall thickness having a greater wall thickness at the distal end than at the proximate end. Examiner’s seems to be saying that the *Field* reference discloses a sheath 40 having a void 50 and that this somehow is translated into a non-uniform wall thickness. Item 50 is a notch and not a void as stated by examiner. Applicant does not claim a void. The *Field* drawing in Fig. 3 or the specification does not disclose a non-uniform wall thickness of any kind or that the thickness of said wall is greater at the distal end than at the proximate end. Further, a wall thickness need not be uniform in its entirety to satisfy the claim so long as at least a portion of the wall is non-uniform. The fact that the *Field* apparatus appears to have a recessed notch is no indication that the wall thickness is any less in the recessed area or that the sheath wall thickness varies from one end to the other.

Examiner has again brought up the 35 USC 112 issue regarding the use of the term “telescopically encasing”. Even though this term was used and accepted in a previous patent claim incorporated into the present application by reference, it was believed that the amendment filed after final, but not entered, placed the application in condition for allowance or in better condition for appeal and over came the 35 USC 112 rejections. Therefore, if the case is reopened for any reason, use of the term “telescopically encasing” can be easily changed to be more acceptable for those unskilled in the art who may not be familiar with the concept of sliding one element inside another.

Examiner rejected applicant’s initial claims 4, 31 and 37 under 35 USC 112 by arguing that applicant miss defined a cleat in the claim as having an anticline shape which was construed by examiner to mean that the cleats are directed toward a central peak which goes against the accepted meaning of a fold with strata sloping downward on both sides.

Applicant made no such definition in the claim. Applicant's initial claim 4 did not include the term anticline. However, claim 4 was summarily rejected under 35 USC 103 as being obvious in view of *Field* and *Johns* and was thus amended to include the term anticline. Applicant was not given an opportunity to address this issue further since claims 31 and 37 were only added at the time of the first office action before prosecution was closed. Now examiner again brings us the rejection of all three claims under 35 USC 103 making new arguments in support of her rejection based on the term "Anticline". The examiner now insists, that the *Johns* reference includes anticline cleats according to her definition. However, applicant argues that the accepted definition of anticline is any structure that slopes in two directions away from a crest. Although the *Johns* reference does show a semi radial rib it would be a stretch to consider it a cleat. Examiner is also arguing that applicant has not narrowed the claim sufficiently in her opinion by limiting positioning of such cleats as in a row along one side of the sheath. Obviously this indicates a prejudgment and that she is unwilling to accept anything broader in scope even with the claim being dependent on potentially allowable claims if the *Field* reference is found to be ineffective under 35 USC 102 or 103.

Regarding claim 38, examiner regards applicant's response to examiner's rejections as being argumentative. It is not understood what examiner is doing in her response if not being argumentative. Examiner has stated that the shape of the opening in the sheath has not been addressed in the specification. Perhaps not to her satisfaction but the opening is certainly supported by the specification on page 10 last paragraph and the drawings as seen in Fig. 10. Therefore, the cited reference of *Field* does not include the rectangular opening limitation claimed by applicant. Examiner's argument that it would be obvious for one skilled in the art to make the opening consistent with an appendage of the user seems to indicate that it would therefore, not be obvious to make the opening rectangular since such a shape would not be consistent with some appendage of the user.

IN SUMMARY:

To anticipate a claimed invention under 35 U.S.C. § 102 (b) a prior art reference must disclose all the elements of the claimed invention or their equivalents, functioning in substantially the same way to produce substantially the same result.

Applicant contends that examiner in this case has failed to show how the cited reference of *Field* complies with 35 U.S.C. § 102 (b) when the referenced invention, which only applies to humans and not animals, is only consistent with the shape of the first joint of a human finger and not the shape of the toe "nail" portion of an animal. The covering is not layered but is only adapted to receive decorations such as beads, sequins or other fashionable accoutrements that may include a detachable artificial finger nail for the purpose of enhancing the appearance. When the referenced invention has attachments, has no non-uniform wall thickness of any kind or a wall thickness greater at its distal end than at the proximate end. Whereby the cited reference teaches the use of the invention as being useful

in protecting and promoting healing of an injured distal portion of the human finger and further provides esthetics by attaching decorative items. Whereas applicant's invention is applied only to the animal's nails and specifically used to protect others and objects from potential injury or damage due to an animals sharp toe nails and has no decorative detachable items.

Applicant also contends that examiner has further failed to logically identify how the *Field* invention is consistent with an animal toe nail or a showing that the cited invention has an exterior layer, lamination or coating, or where the cited invention teaches a partial delamination.

Applicant also contends that examiner has further failed to logically explain how the *Field* invention is considered to be a polymeric when the reference only teaches the use of a rigid or pliable material such as a formable materials such as plastic or cloth. Plastic simply meaning a material that is formable where as applicant specifies a particular type of material such as a Polymer (a limitation).

Applicant also contends that examiner has further failed to properly identify where the *Field* invention shows a sheath (not including its accessory items) with a non-uniform wall thickness. A non existent hole referred to by Examiner is not a wall and has nothing to do with the wall thickness.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. However, patentability shall not be negated by the manner in which the invention was made."

To determine the differences between the prior art, which in this case is disputed, and applicant's claims under 35 U.S.C. § 103 requires interpreting the claim language, and then considering both the invention and the prior art reference as a whole to determine if the invention would have been obvious.

The rules under 35 U.S.C. § 103 also require that the cited reference must teach, suggest or motivate in some way one of ordinary skill within the art. To use its teachings to produce an apparatus that functions substantially in the same manner as applicant's invention to produce substantially the same intended result with some reasonable expectation of success.

In this case there are a considerable number of anatomic problems between a human finger and an animal's toe or toe nail. Anyone familiar with the Veterinary arts would expect a multitude of functional problems associated with any attempt to apply the Field Finger

guard to an animal's toe or toenail. According to Field, one would need to "SLIP" the DIGIT GUARD (without adhesive) "SNUGGLY" onto the toe of an animal; the animal would immediately most certainly pull it off. In small part because animals have no regard for a manicure, but instead will not tolerate such a cumbersome object or any object slipped onto their toe, as is the nature of animals as anyone trained in the veterinary arts would expect. However if as Examiner suggest one were to use an adhesive in some manner to adhere the device to the animals toe and not to only the nail, it would most assuredly cause pododermatitis, that is an infection of the foot or toes. This would rapidly occur because the adhesive would do its job by forming a bond between living tissue of the toe and the device, causing first irritation to the tissues and then secondary infection to the tissues. This would be of common sense to anybody trained in Veterinary arts. Further, the activity of cats to use a litter box and the contamination potential associated with such activities with regards to irritated tissues should be considered as well. Whereas applicant's current invention has nothing to do with toes or living tissues, but only pertains to applying "a sheath having an internal and external shape which is consistent with that of an animal claw" to the cornified non living structure of the claw exclusive of any part of the toe.

Further, the cited reference of *Field* does not motivate or inspire one of ordinary skill to do anything more than decorate a finger covering by adding an artificial finger nail to one side of the finger covering. Whereas, applicant's specification clearly states and claims that the claimed nail sheath distinguishes over the prior art shown in Fig. 1-9 by adding a *coating encompassing* at least a portion of the prior art nail sheath for the purpose of improving the longevity of the sheath due to wear resulting from contact with the ground.

Applicant therefore, further contends that examiner has failed to show how claims rejected by examiner under 35 U.S.C. § 103 comply with the rules according to MPEP 2141.02 without the use of hindsight when the cited *Field* reference does not teach, motivate or suggest the need for cleats of any kind regardless of shape or location, nor does the reference teach, motivate or suggest the need to make the sheath a different color than any applied decoration or suggest a non-uniform wall thickness.

Applicant therefore, contends that examiner has failed to show how claims rejected by examiner under 35 U.S.C. § 103 comply with MPEP 2141.02 (iii) and (iv) when the problem identified and rectified by applicant's invention is to prolong the life of the sheath. No such remedy is disclosed by the reference, thus when taken as a whole the intended purpose of the invention is completely different from the reference. This taken in addition to the fact the cited invention is made in an entirely different manner for an entirely different purpose makes the reference non-analogous and non-compliant with the rule.

Applicant also contends that examiner has not complied with MPEP 2141.02 (v) by not defining applicant's invention as whole by failing to look closely and take into account the subject matter inherent in the disclosed specification.

Applicant contends that examiner has not complied with MPEP 2141.02 (vi) by not defining the cited reference of *Field* as whole in view of applicant's invention. Instead examiner has dissected applicant's claims and applied equivalency for each element by misidentifying elements in the reference.

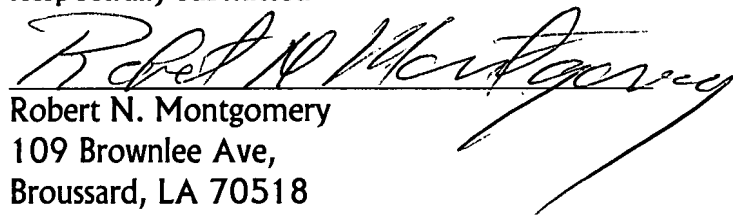
Applicant also contends that examiner has not complied with MPEP 2143.01 and MPEP 2143.03 by failing to point out specific suggestions or motivations to modify the cited reference, without the use of hindsight, to include the claimed elements and or limitations and that all claim limitation must also be specifically suggested or taught. Examiner's response that the claim is obvious is insufficient and improper without support.

Applicant further contends that examiner has not complied with MPEP 2144 because, in many cases, examiner has misidentified elements in the cited reference using applicant's claim terminology and thereby assuming mechanical and functional equivalency not taught by the reference. Further, the courts have ruled that simply because some components are mechanically and functionally equivalent they are not necessarily obvious. I.e. the use of a plastic or cloth does not preclude the use of a polymeric chemically compounded material. Further, a layer, coating and a lamination are not all equivalents to a detachable decoration.

Applicant contends that examiner has failed to comply with 2111.01 not giving words in the claims their plain meaning or the meaning established within the specification. The claim language should be aided by explanation contained in the written description. In this case examiner has gone to great lengths to divorce the claims from the specification. Examiner also fails to interpret the claims in their broadest scope in view of the specification.

For all of the above reasons, it is believed that the rejections should be over turned and remanded with instructions for further prosecution.

Respectfully submitted



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